

### **REMARKS**

This responds to the Office Action dated July 12, 2006.

No claims are amended. No claims are canceled or added. As a result, claims 1-46 are now pending in this application.

#### **§102 Rejection of the Claims**

Claims 1-5, 10-19, 24-27, 30-42 and 46 were rejected under 35 U.S.C. § 102(e) as being anticipated by Nichols et al. (U.S. Patent No. 6,363,282, hereinafter as “Nichols”).

Applicant respectfully traverses the rejection because a *prima facie* case of anticipation has not been made. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of anticipation as claim 1 recites, among other things, “central server coupled to the network and including at least one prescription system for prescribing at least one programmable parameter of a medical device based upon at least one characteristic of a patient; and a medical device programmer coupled to the network and configured to communicate at least one characteristic of a patient to the central server via the network, to receive at least one programmable parameter from the central server via the network, and to program the medical device using the at least one programmable parameter.” Although Nichols relates to a high speed computer network system

located in a remote expert data center and remote monitoring and upgrade of a *programmer*<sup>1</sup>, it does not teach “at least one prescription system for prescribing at least one programmable parameter of a medical device based upon at least one characteristic of a patient,” as recited in claim 1. Further, the Nichols patent relates to ensuring compatibility between a programmer 20 and the software application through a software database 128 having information and data related to rules and regulations for applications for programmer 20<sup>2</sup>.

Further, Applicant cannot find, among other things, wherein the reason for web-based remote service to programmer is for “at least one prescription system for prescribing at least one programmable parameter of a medical device,” as recited in claim 1. Independent claims 15, 25 and 35 contain similar elements as in claim 1 and are believed allowable for at least the reasons above. Therefore, Applicant respectfully requests reconsideration and allowance of claims 1-5, 10-19, 24-27, 30-42 and 46.

#### §103 Rejection of the Claims

Claims 6-9, 20-23, 28, 29 and 43-45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nichols et al. (U.S. Patent No. 6,363,282) in view of Haller (U.S. Patent No. 6,804,558, hereinafter as “Haller”).

Applicant respectfully traverses this rejection as the Office Action has not made a *prima facie* case of obviousness. An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

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<sup>1</sup> Nichols, Col. 13, lines 25-36.

<sup>2</sup> Nichols, Col. 13, line 58 to Col. 14, line 12.

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for the following reasons:

Claims 6-9 ultimately depend on claim 1 and are believed to be allowable at least for the reasons stated previously for claim 1. Additionally, the Nichols patent relates to mobile telephones or PDAs to communicate with IMDs. Either Nichols or Haller fail to teach or suggest, either individually or in combination, the claim elements of “at least one of the central server and the medical device programmer is configured to allow a user to select one of the expert and custom prescription systems,” as claimed in claim 9. Applicant is unable to find in the proposed combination of references, any disclosure of the information related to a custom prescription system as recited in claims 6-9. Claims 20-23, 28, 29 and 43-45 contain similar elements as in claims 6-6 and are believed allowable for at least the reasons above.

Additionally, a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963).

Nichols relates remote monitoring and upgrade of a programmer. Haller relates to a mobile telephone or PDA communicating with an IMD. Haller further suggests that the need for a programmer may be eliminated with this technology<sup>3</sup>. The references teach away from the claimed combination because utilizing the teachings of Haller for using a mobile telephone or PDA to communicate with an IMD would eliminate the need for a programmer as required by Nichols.

Therefore, Applicant respectfully requests reconsideration and allowance of claims 6-9, 20-23, 28, 29 and 43-45.

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<sup>3</sup> Haller, Col. 18, lines 55-61.

*Inconsistency*

The Office Action failed to address claim 46 in the most recent response. Applicant respectfully requests the Examiner to address this discrepancy in the next correspondence.

**CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 349-9587 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

JULIO C. SPINELLI ET AL.

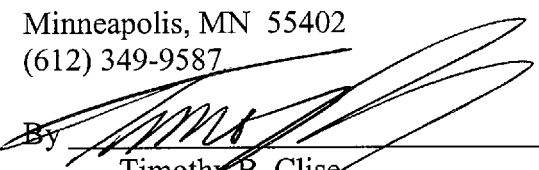
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12 Sept '06

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12 day of September 2006.

Name

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